

**REMARKS**

Claims 1, 4, 6-11, 14 and 16-22 are pending in the application.

Claim 2-3, 5, 12-13 and 15 were canceled.

Claims 1, 11 and 21 are amended.

Reconsideration and allowance of claims as amended is respectfully requested in view of the following:

**The rejection of claims as being unpatentable over Sleeman, in view of Saunders, and in further view of Severson et al:**

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 USC §103(a) as being unpatentable over Sleeman (U.S. 20040260843) in view of Saunders ("Newcard Exposed"), and in further view of Severson et al (U.S. 6191499), hereafter "Severson." Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

The Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner can not establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains... (emphasis added)

Thus when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Independent claim 1 includes: "...A Newcard device to electrically couple a first and second subsystem of a computer...[the second subsystem including a user console] [and] the

Newcard device comprising...power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device."

Independent claim 11 includes: "A method for partitioning a computer into subsystems, the method comprising: preparing a first subsystem...preparing a second subsystem [the second subsystem including a user console]...electrically coupling the first and second subsystems by at least one Newcard device, wherein the at least one Newcard device [includes]...providing power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device."

Independent claim 21 includes: "An information handling system comprising: a first subsystem...a second subsystem [the second subsystem including a user console]...and a Newcard device electrically coupled to the first and second subsystems, wherein the Newcard device includes...power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device."

Sleeman, Saunders, and Severson, alone or in combination, do not disclose all elements of independent claims 1, 11 and 21. The Examiner states that Sleeman as modified by Saunders does not explicitly disclose providing power to the second subsystem including the user console, whereby the power adapter is operable to receive AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device. The Examiner contends that Severson cures this deficiency, but applicant submits that Severson does not. The Examiner states that Figure 3 of Severson illustrates a card within a host system comprising an external

power source 340 coupled to a system power supply 330 that is coupled to all subsystems therein via voltage regulator modules (VRM). The Examiner interprets this as the VRM providing redundant and regulated power to each subsystem. Applicants submit however that Severson does not disclose redundant power to a subsystem. Figure 3 of Severson discloses a multiple processor apparatus 310 that includes multiple circuit cards (320a, 320b, 320c) with VRM and processor pairs coupled to each card (360a/350a, 360b/350b, 360c/350c respectively). There is only one power source for each circuit card. Specifically Severson discloses a power supply 330 that converts a source voltage from an external power source 340, which may be a commercial power source or a battery bank, to a voltage level that is suitable for use on the circuit cards (320a, 320b, 320c) (col. 4 line 29-35). Thus, Severson does not disclose a redundant power source to the circuit cards (i.e. subsystems). Severson illustrates redundancy only in that there are redundant subsystems so that if one subsystem (i.e. processor/VRM pair) fails, there are other subsystems to allow the multiple processor apparatus 310 to continue to function; this redundancy is inapplicable to the claims of the present disclosure related to power to a subsystem (col. 4 lines 44-50).

Furthermore, the cited references lack several elements required by claims 1, 11 and 21. For instance, Severson does not disclose power to a subsystem that includes a user console. Severson does not disclose converting an AC power input to various voltages required by the user console. Finally, Sleeman, Saunders and Severson, alone or in combination do not disclose a second system deriving power from the computer via a powerline on the Newcard device. Therefore claims 1, 11 and 21, and the claims that depend therefrom, are submitted to be allowable.

Dependant claims 4 and 14 require a connector, coupling the first subsystem to the first port of the Newcard device, which includes 28 pins. The Examiner states that Saunders discloses this 28 pin connector on its pin out page with 26 pins per slot and 2 reserved pins to comprise a total of 28. However, sheet 18 of Saunders illustrates the pin out showing 26 pins inclusive of two reserved pins (pins 21 and 22). As such, every element of the claims 4 and 14 are not disclosed by the prior art for at least this reason.

Dependant claims 8 and 18 require partitioning the computer into a first subsystem and a second subsystem based upon a first predefined criteria of heat generation and a second

predefined criteria of noise generation. All elements of claims 8 and 18 are not taught by the prior art. The Examiner submits that Saunders discloses predefined criteria of heat generation and noise generation on sheet 19. Applicants submit that sheet 19 of Saunders illustrates only the need to manage power dissipation within the Newcard. The power management scheme or thermal limits of the Newcard itself do not disclose separating a computer into two subsections based upon heat generation and noise generation. However, the Examiner is respectfully requested to clarify this rejection as paragraph 5 seems to contain errors rendering it difficult for applicants to adequately appreciate the Examiner's position. Nonetheless, for at least these reasons, claims 8 and 18 are submitted to be allowable.

It is impossible to render the subject matter of the claims as a whole obvious based on any combination of these references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness cannot be met and the rejection of claims 1, 4, 6-11, 14 and 16-22 is not applicable.

There is still another compelling, mutually exclusive, reason why Severson can not be combined with Sleeman and/or Saunders and applied to reject claims 1, 4, 6-11, 14 and 16-22 under 35 U.S.C. §103(a). The PTO provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing for two subsystems connected by a Newcard with power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device. Thus, none of these references provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

The MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in the references for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable. Therefore claims 1, 4, 6-11, 14 and 16-22 are submitted to be allowable for at least these reasons.

**The rejection of claims as being unpatentable over Sleeman, in view of Saunders as applied above, and in further view of Cheng et al:**

Claims 9-10 and 19-20 are rejected under 35 USC §103(a) as being unpatentable over Sleeman (U.S. 20040260843) in view of Saunders ("Newcard Exposed"), and in further view of Cheng et al (U.S. 6191499), hereafter "Cheng." Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

The Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner can not establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains... (emphasis added)

Thus when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Claims 9-10 and 19-20 are dependant upon and further limit independent claims 1 and 11 respectively. As such, they are allowable for at least the same reasons as claim 1 and 11 as discussed above. All elements of the claims at issue are not disclosed in the prior art namely, providing power to the second subsystem including the user console, whereby the power adapter is operable to receive AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device. Cheng does not cure this deficiency. Therefore claims 9-10 and 19-20 are submitted to be allowable for at least these reasons.

Moreover, Sleeman, Saunders and Cheng, alone or in combination, do not disclose all additional elements of dependant claims 9 or 19. Claim 9 and 19 both read in part: the "first subsystem is placed at a sufficient distance away from a user to substantially reduce effects of the heat generation and the noise generation." The Examiner states that Sleeman as modified by Saunders does not disclose the device or method wherein the first subsystem is placed at a sufficient distance away from a user to substantially reduce effects of the heat generation and the noise generation. The applicant submits that Cheng does not cure this deficiency. The Examiner states that Cheng teaches placing a CPU fan strategically "near the vent holes to monitor the temperature of the CPU to drive the CPU and auxiliary fans in cooling the computer system" and that this strategic placement would be based on heat and noise generation. Cheng however does not teach strategic placement of the CPU fan, but states that the CPU fan is attached to the CPU heatsink and that the auxiliary fan is "typically" being mounted inside the computer case near the vent holes (col. 3 lines 20-23). Cheng states only that there should be a "strategic" placement of a thermistor; this placement unrelated to the user's position but strategically positioned to measure the vital temperature of the computer system. Moreover, Cheng discloses only a system wherein the speed of the fan is reduced or increased in response to the vital temperature, not distancing components from a user. As such, claims 9 and 19 are submitted to be allowable for at least these reasons.

There is still another compelling, mutually exclusive, reason why Cheng can not be combined with Sleeman and Saunders and applied to reject claims 9-10 and 19-20 under 35 U.S.C. §103(a).

The PTO provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing for a first subsystem placed sufficient distance away from a user to substantially reduce effects of heat generation and noise generation or a subsystem wherein an operation of the processor and the fan assembly cause heat generation and noise generation. Thus, none of these references provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

The MPEP further provides at §2143.01:

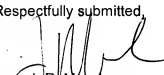
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in the references for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable. Therefore claims 9-10 and 19-20 are submitted to be allowable for at least these reasons.

In view of all of the above, it is respectfully submitted that claims 1, 4, 6-11, 14, and 16-22 are in condition for allowance. Accordingly, an early Notice of Allowance for the claims is courteously solicited.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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